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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/823,219	03/29/2001	George R. Borden IV	KLR 7146.091	6071
55648	7590	07/28/2006	EXAMINER	
KEVIN L. RUSSELL CHERNOFF, VILHAUER, MCCLUNG & STENZEL LLP 1600 ODSTOWER 601 SW SECOND AVENUE PORTLAND, OR 97204			VU, THANH T	
		ART UNIT	PAPER NUMBER	
		2174		

DATE MAILED: 07/28/2006.

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/823,219	BORDEN, GEORGE R.	
	Examiner	Art Unit	
	Thanh T. Vu	2174	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 03 May 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 6-8 and 16 is/are pending in the application.
- 4a) Of the above claim(s) 16 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 6-8 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date: _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This communication is responsive to Amendment, filed 05/03/2006.

Claims 6-8, and 16 are pending in this application. In the Amendment, claims 6 and 16 were amended. This action is made Final.

Election/Restrictions

Newly amended claim 16 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

I. Claims 6-8 are drawn to video interface classified in class 715/719.

II. Claim 16 is drawn to formatting information in separate file classified in 715/522.

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as an application deals specifically with image or video data, invention II is different distinct invention and has separate utility such as layout specifications are stored separately from the data to which such specifications are applied. See MPEP § 806.05(d).

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 16 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it

pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 6-8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitations of “said computer determining potential desirable additional image content for said user based upon a comparison between said list and said additional image content free from said additional image content being selected by the user for inclusion in said list” are not clearly described in the specification. Accordingly, the examiner assumes the claim language as “said computer determining potential desirable additional image content for said user based upon said list, free from said additional image content being selected by the user for inclusion in said list”. The following rejections are based on that assumption.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 recites “indicating to said user the potential desirability of adding said at least one of said additional digital image and said additional digital video without requiring interruption of the user's work flow with a decision operation to be made by said user before continuing said work flow, wherein said system adds said additional content to said list by a user

interaction with said at least one of said additional digital image and said additional digital video after said indicating”. The claim requires the limitation of “indicating to said user the potential desirability of adding said at least one of said additional digital image and said additional digital video without requiring interruption of the user's work flow”. However, the limitations come after the limitation of “without requiring interruption of the user's work flow” are “a decision operation to be made by the user before continuing said work flow”, and “said system adds said additional content to said list by user interaction with said at least one of said additional digital image and said additional digital video after said indicating”. It is unclear as to what is meant by “without requiring interruption of the user's work flow” since the claim language requires user's intervention before continuing said work flow. Accordingly, the examiner assumes the limitation as “indicating to said user the potential desirability of adding said at least one of said additional digital image and said additional digital video without requiring interruption of the user's work flow”. The following rejections are based on that assumption.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Echerer et al. (U.S. Pat. No. 5,740,267) and Window Explorer.

Per claim 6, Window Explorer teaches a method of selecting desirable images for a user comprising:

- (a) maintaining a list of a plurality of desirable user-selected image content that includes at least one of a digital image and a digital video (fig. 1; col. 57-60);
- (b) said computer determining potential additional image content for said user based upon said list, free from said additional image content being selected by said user for inclusion in said list, that includes at least one of an additional digital image and an additional digital video (col. 9, lines 30-36; col. 10, lines 24-28; col. 10, lines 49-58);

Echerer does not teach said computer indicating to said user the potential desirability of adding said at least one of said additional digital image and said additional digital video without requiring interruption of the user's work flow. However, Window Explorer teaches said computer indicating to said user the potential desirability of adding said at least one of said additional digital image and said additional digital video without requiring interruption of the user's work flow (figs. 2 and 5; indicator 22). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include the teaching of Window Explorer in the invention of Echerer in order to provide the user with a file management feature that give the user an indication of total files in a list.

Per claim 7, Window Explorer teaches the method of claim 6 wherein said indicating includes a visual indication (figs. 2 and 5; indicator 22).

Per claims 8, the modified Echerer teaches the method of claim 6, but does not teach said indicating includes an audible indication. Official Notice is taken that the use of audible sound indicator is well known in the art. It would have been obvious to an artisan at the time of the invention to combine such a feature with Window Explorer in order to inform users quickly and conveniently without the need for the user to read the text indicator.

Response to Arguments

Applicant's arguments with respect to the Amendment have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanh T. Vu whose telephone number is (571) 272-4073. The examiner can normally be reached on Mon-Thur and every other Fri 7:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine L. Kincaid can be reached on (571) 272-4063. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

T. Vu

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